

REMARKS/ARGUMENTS

In response to the Office Action mailed July 12, 2005, Applicant amends his application and requests reconsideration in view of the amendments and the following remarks. In this amendment, claims 1 and 8 have been amended, no claims have been cancelled without prejudice and no claims have been added so that claims 1, 2 and 4-8 remain pending.

Claim 8 was rejected as being anticipated by U.S. Patent No. 6,645,238 to Smith. (Smith). This rejection is respectfully traversed.

Anticipation exists only if all of the elements of the claimed invention are present in a system or method disclosed, expressly or inherently, in a single prior art reference. Therefore, if it can be shown that there is one difference between the claimed invention and what is disclosed in the single reference, there can be no anticipation.

Smith discloses a device having a sheath assembly. The sheath assembly includes one or more skids. The skids comprise inner and outer layers made of different materials, including ceramics.

Claims 1 and 8 include sheaths that have inner and outer layers. Smith does not teach or even suggest a sheath having a ceramic layer, but rather the extra elements; namely, the skids. Since Smith fails to teach or suggest this unique construction, there can be no anticipation. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1, 2, 4-7 were rejected as being unpatentable over Smith. This rejection is respectfully traversed.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation,

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In *re Vaeck*, 947 F.2d, 488, 20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1074). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In *re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In *re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

Smith discloses a device with skids. The skids are an added component to the sheath which would tend to increase its diameter. Larger diameters in delivery devices are not desired. Therefore, Applicant respectfully reiterates his argument that Smith fails to disclose or even suggest the invention of independent Claims 1 and 8. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

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A favorable action on the merits is earnestly solicited.

Respectfully submitted,

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